

Application No. 09/752,199
Response dated January 18, 2005
Reply to Office Action dated October 18, 2005
Express Mail EV406652417US

Remarks/Arguments

The Office Action dated October 18, 2004, has been noted and its contents carefully studied. Reconsideration of the Rejection under 35 U.S.C §102, §103 and §112 is courteously requested.

Initially, with respect to the Examiner's rejection of claims 2 and 14 under 35 U.S.C §112 as being indefinite because it is unclear as to what the limitation substantially refers, it is respectfully urged that in considering the limitation, the Examiner must consider the discussion in the application at the time that the disclosure is made when the application is filed. The Examiner has referenced various SCSI protocols including iSCSI for sending SCSI over TCP/IP.

In this regard, it is noted that iSCSI was not contemplated until at least 2001 and that the standard was actually introduced in 2002. In contrast, this application was filed in 2000 and thus, the claims clearly provided distinguishable limitations. More specifically, in making the rejection, the Examiner needs to consider the knowledge of ordinary skill at the time the application was made and needs to consider the claims from which the objected to claims, i.e., claims 2 and 14, are dependent from.

Claims 1 and 3 include limitations relating to the encoding step in which the SCSI request is encoded with a tag identifying the request as an SCSI request. Claim 2 and 14 further provide that the field of the SCSI request is structured in a manner substantially the same as a direct SCSI request from a host system to a target device. As such, it is believed that the objected to claims clearly add a further distinction, and reference to a later established standard post the filing of the application is not appropriate in making such a rejection. Accordingly, it is believed sufficient reasons have been provided to enable the Examiner to withdraw the 35 U.S.C §112 rejection of the claims.

Turning now to the invention as claimed, in its broadest aspect, the method claims provide a way of transmitting requests to a target device in which a direct TCP/IP connection is established between a computer system and a target device. A SCSI request is encoded with a tag identifying the SCSI request, and is structured with a request IP/ID. The tagged SCSI request is sent to the target device and the request IP/ID of the SCSI request is returned from the target device to the computer system.

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Claim 13 provides the invention in a system aspect in which a computer system is connectable directly through a TCP/IP connection to a target device. The system is configured for encoding a SCSI request for the tag identifying the request as an SCSI request, and for structuring the request with an IP/ID. An instruction module in the computer system serves to send the tagged SCSI request to the target device from the computer system as directly connected through a TCP/IP connection to the target device. The target device is programmed to accept the SCSI request and for returning the request IP/ID of the SCSI request and a reply to the computer system when connected thereto.

Initially, it is noted that the claims have been rejected under 35 U.S.C §102 and/or §103 in light of U.S. Patent No. 6,697,895 to Sherritt et al. Sherritt et al. was issued as a patent on February 24, 2004 and was filed on November 10, 2000, having an effective date as a reference of November 10, 2000.

As a result, reference is made to MPEP §706.02(b) which provides that a rejection based on 35 U.S.C §102(e) can be overcome by filing an affidavit or declaration under 37 CFR §1.131 showing prior invention. The effective date of the U.S. patent is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C §102(e) which provides in part two thereof that the effective date of the patent is the date of filing.

To overcome this rejection, attached is the Declaration under 37 CFR §1.131 of Dean Throop, the inventor in the above-identified application, establishing that the invention was reduced to practice through development and operated successfully at least as early as January of the year 2000, almost one year prior to the effective date of the Sherritt et al. reference. To support Applicant's Declaration, attached thereto is the Invention Disclosure Form filled out by the inventor as part of his employment duties, referencing the relevant dates. Specific reference is made to page 2 of the Invention Disclosure form which documents the relevant dates. Pages 3 and 4 describe the invention in a manner which proves reduction to practice. Further, attached to the Declaration and referred to therein is an internal publication of the Assignee in the above-identified application which discusses the invention in great detail, and finds commonality in disclosure with the above-identified application, particularly as to pages 3, 4 and 5 of the publication. As such, it is respectfully urged that Sherritt et al. is not effective as a reference and that the rejection under 35 U.S.C §102 and §103 should be withdrawn.

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Notwithstanding the fact that Sherritt is not effective as a reference, it is also respectfully urged that Sherritt even if effective as a reference fails to anticipate under 35 U.S.C §102 and/or render obvious Applicant's claimed invention under 35 U.S.C §103 for the following reasons.

More specifically, Sherritt et al. teaches an apparatus and methodology that allows a host computer to control a data storage device that is remotely located relative to the host computer using the same software that is used to control data storage devices that are locally or directly connected to the host computer. More specifically, the host computer includes a virtual adapter that is capable of converting unencoded SCSI, and related information from an operating system into encoded SCSI command related information that is capable of being transmitted over a network to a remotely located SCSI storage device. A remotely located SCSI state storage device includes a controller that decodes the encoded SCSI command related information received from the network so that the SCSI command related information can be applied to a SCSI tape storage unit. The operating system must initially identify all the local SCSI devices associated with the host computer, but it is not possible to identify a remote SCSI device that the host computer communicates via the virtual adapter at the point in time because the operating system has not reached the point in the boot up process at which network communications are enabled.

This has nothing to do with Applicant's claimed invention which provides for making SCSI requests over a TCP/IP connection directly to target devices and not through the network. These features are clearly recited in Applicant's claimed and are not shown or obvious from the teaching of the Sherritt et al. reference even if it were effective if as a reference.

Thus, it is urged that Sherritt is not effective as a reference and its effectiveness as a reference has been overcome by the filing herewith of the inventor's 37 CFR §1.131 Declaration, and that even if effective as a reference, still fails to show or suggest in an obvious manner Applicant's claimed invention.

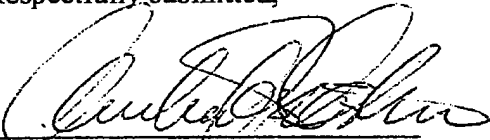
The remaining references have been reviewed and are not believed to be any more pertinent to the claimed invention than the above-discussed reference. Thus, for the sake of brevity, they will not be discussed further herein.

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For the foregoing reasons, it is respectfully urged that the application and claims are now in condition for allowance. Nonetheless, should the Examiner still have any comments, questions or suggestions of a nature necessary to resolve any outstanding issues, he is courteously requested to telephone the undersigned at the number listed below.

Dated: January 18, 2005

Respectfully submitted,



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Enclosures

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